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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/849,683

05/04/2001

Rebanta Bandyopadhyay

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05/10/2005

PHARMACIA CORPORATION
GLOBAL PATENT DEPARTMENT
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EXAMINER

JONES, DWAYNE C

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/849,683	Applicant(s) BANDYOPADHYAY ET AL.	
	Examiner Dwayne C. Jones	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28FEB2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11, and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

1. Claims 1, 4-11, and 13-15 are pending.
2. Claims 1, 4-11, and 13-15 are rejected.
3. Claims 16-39 are cancelled as per the amendment of October 28, 2004.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 4-11, and 13-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 4-11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayly et al. of U.S. Patent No. 5,994,379 in view of Stjernschantz et al. cf WO 00/25771 A1 possessing a publication date of May 11, 2000. Bayly et al. disclose COX "is an enzyme implicated in the mediation of pain . . . and inflammation" and that there are two isoforms, namely COX-1 and COX-2. Bayly et al. also disclose that COX-2 is implicated in the pathologies, such as pain and inflammation, (see column 1, lines 14-27). The prior art reference of Bayly et al. explicitly teach and provide motivation to the skilled artisan to use an inhibitor of COX-2 to treat pain and inflammation in an individual, (see column 9, lines 4-34). Bayly et al. also teach of the compounds of formula (I).

9. The prior art reference of Stjernschantz et al. teach of employing COX-2 inhibitors to treat inflammatory conditions of the eye. In addition, Stjernschantz et al. teach of treating glaucoma (see page 1, lines 1-4) In particular, the prior art reference of Stjernschantz et al. specifically teach of using the COX-2 inhibitors of celecoxib,

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rofecoxib, and DuP 697, (see claim 7). Stjernschantz et al. also teach and provide motivation to the skilled artisan to include ophthalmologically compatible vehicles, which may be employed for preparing compositions of this invention with aqueous solutions, preservatives, polymers to increase the viscosity of the solutions, inclusion complexes. These pharmaceutically acceptable adjuvants could increase the contact time of the agent thus increasing its effectiveness to the eye. One having ordinary skill in the art is clearly taught of treating the ailments of pain and inflammation with the administration of a COX-2 inhibitor. Moreover, one having ordinary skill in the art is provided with motivation from these prior art references in order to treat pain and inflammation from a variety of ailments, with a COX-2 inhibitor, such as those disclosed by Stjernschantz et al., namely the COX-2 inhibitors of celecoxib, rofecoxib, and DuP 697. From these teachings, one having ordinary skill in the art would have been motivated to include other known COX-2 inhibitors for the treatment of inflammatory and painful conditions of the eye.

Obviousness-type Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

11. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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12. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. The provisional rejection of claims 1, 4-11, and 13-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23, 24, 26, and 27 of copending Application No. 09/904,098 is maintained and repeated. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to the treatment of COX-2 mediated disorders of the eye with the administration of a selective COX-2 inhibitor.

14. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1, 4-11, and 13-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of copending Application No. 10/332,320. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to the treatment of COX-2 mediated disorders of the eye with the administration of a selective COX-2 inhibitor. The skilled artisan would have been motivated to use the COX-2 inhibitors of the instantly claimed subject matter for inter alia, pain from retinal detachment surgery with the administration of COX-2 inhibitors.

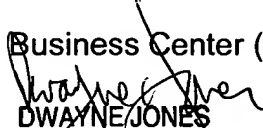
16. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, and Fridays from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, may be reached at (571) 272-0951. The official fax No. for correspondence is (571)-273-8300.

Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see <http://pair-direct.uspto.gov>. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll free).


DWAYNE JONES
PRIMARY EXAMINER
Tech. Ctr. 1614
May 6, 2005